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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,225	07/25/2003	Luis M. Ybarra	YLM 8470.1	2438
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2147	7590	09/24/2004
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EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,225

Applicant(s)

YBARRA, LUIS M.

Examiner

Hadi Shakeri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>072503</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 13, 14 and 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "one or more of the teeth of the rack" in line 24. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 5, 13 and 19, a stop in the form of a guide member adjacent to the distal end of the outer member (18) renders the claims indefinite. It appears that the circular opening of the (44) as shown in the embodiment in Figs. 7 and 8 is being claimed in claim 5, which depends on claim 4, reciting a stop at the distal end of the outer member, i.e., (44), however, the guide as claimed in claim 13, which extends to a location adjacent to the intermediate portion of the connector places doubts as to what is being claimed by the "guide". Specification as originally filed does not provide sufficient disclosure to define the term, however, 112 1st paragraph rejections are not applied at this time, since the deficiencies appear to be more of clarity rather than enablement.

Regarding claim 14, while the extension includes a plurality of spring biased detents, (24) (29), and a plurality of firm connections between the sleeve and connector is formed, i.e., (29) engaged with one of bores (36) at different extensions, "a plurality" of spring biased detents to form "a plurality" of firm selectively removable connections between the sleeve and the rod as recited is indefinite, since only (29) is engaged in one of the bores 36. Claims as recited appear to claim, e.g., two detents (29) at the proximal end (28) to engage two bores (36) not supported

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in the specification. It appears that the Applicant is attempting to claim a plurality of bores

(36). Applicant may also wish to amend by reciting, --...selectively engageable connections...--

Regarding claims 16-20, "means for spacing" is objected to, an attempt is made to use a "means" clause to recite a claim element as a means for performing a specified function, i.e., "spacing means". However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. However, since specification clearly discloses that only a smaller cross section for the intermediate portion is being claimed for a non-binding relationship between the sleeve and the connector a rejection under 112, 2nd paragraph is not applied and the claims are only objected. Applicant is required to amend the claim language by deleting the "means" clause.

Claim Rejections - 35 USC § 102

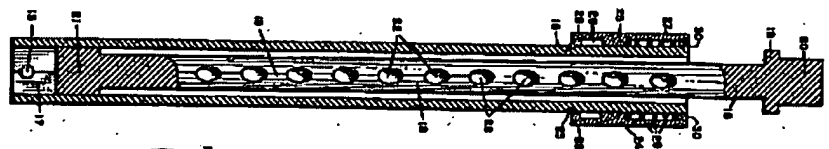
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Clothier et al., US Patent No. 2,963,930.

Clothier et al. discloses all the limitations of claims 1, 11 and 16, i.e., an adjustable extension comprising an outer member (10), a longitudinally extending connector (18), a receiver (15) (17) at a proximal end of the outer member, a longitudinal extending central cavity (17) with a driving element, square shaped, cooperating with a driven element (21) of the rod, a distal end of the rod having a driving member (20), the rod having an intermediate portion with a smaller



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transverse dimension defining a non-binding relationship between the outer member and the rod, the central cavity having a non-circular cross-section, the proximal end (21) of the rod having a non-circular cross section with a circular intermediate portion, the longitudinally extending connector having a stop (19) to limit the telescoping movement.

Regarding claims 2, 6-10, 12, 14 (as best understood), 15, 17 and 20, Clothier et al. meets the limitations.

Regarding claims 4, 5, 13, 18 and 19, Clothier et al. meets the limitations, i.e., a stop at the distal end of the outer surface (peripheral end surface abutting against flange 19), meeting the limitation of a "guide".

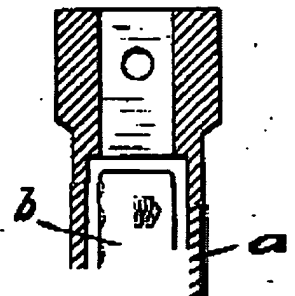
Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clothier et al. in view of J. Condor, US Patent No. 2,438,633.

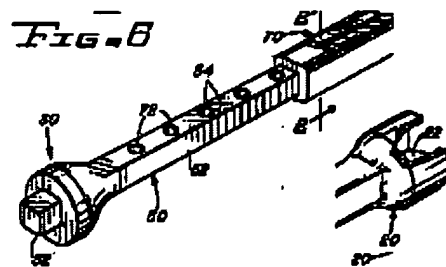
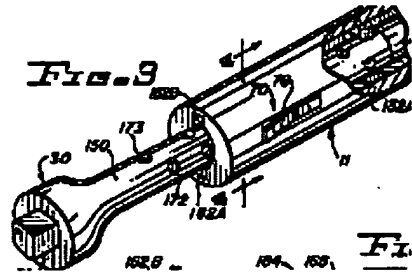
Clothier et al. discloses all the limitations of claim 3, except for a stop in the cavity. Condor teaches an extendable tool with a sleeve (a), and an extending rod (b) in which the means for limiting the movement of the rod (b) within the sleeve (a) is a stop (reduced diameter) at the proximal end of the outer member within the cavity. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Clothier with the stop as taught by Condor as an economical means of limiting the relative movement of the rod within the sleeve.



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7. Claims 1-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Newby et al. (4,376,397) in view of McBride (4,409,86) or Mathews (4,960,015).

Newby et al. discloses all of the limitations of claims 1, 11 and 16, i.e., an adjustable extension for driving tools comprising an outer tubular member (60) (160), the outer tubular member having a proximal end and a distal end, the adjustable extension having a longitudinally extending connector (50) (150), the longitudinally extending connector having a proximal end and a distal end, the outer tubular member having a receiver (22) at the proximal end thereof for receiving a driving tool, the tubular member having a longitudinally extending central cavity, the central cavity having a non-circular cross-section, the adjustable extension further having the longitudinally extending connector adjustably received within the longitudinally extending central cavity of the tubular member for relative telescoping movement thereto, the longitudinally extending connector having its proximal end received within the central cavity of the tubular member, the proximal end of the longitudinally extending connector having a non-circular cross-sectional shape cooperating with the central cavity of the tubular member, the longitudinally extending connector having its distal end extending out of the longitudinally extending central cavity and beyond the distal end of the tubular member, the distal end of the longitudinally extending connector having a tool driving member (32), the longitudinally extending connector having an intermediate portion between its proximal and distal ends, the intermediate portion of the longitudinally extending connector being substantially circular in cross-section and being of

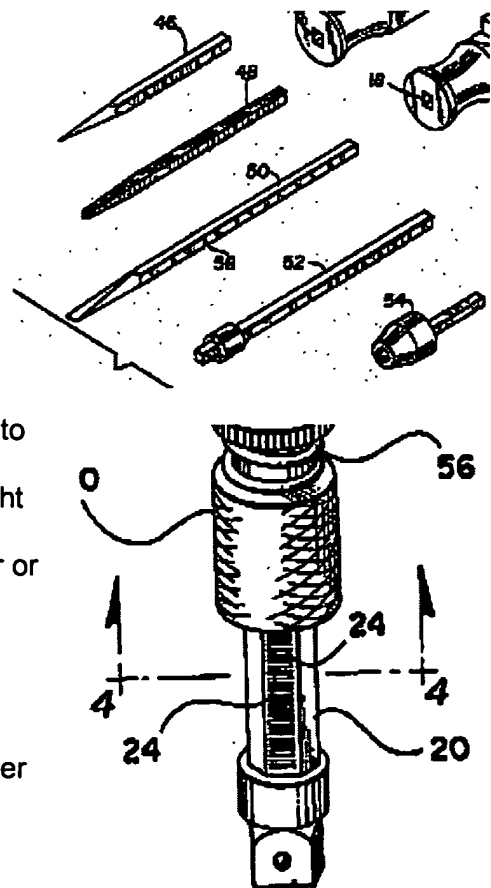


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a smaller transverse dimension than the proximal end of the longitudinally extending connector, the intermediate portion of the longitudinally extending connector being spaced from the central cavity of the outer tubular member in a non-binding relationship and including a rack with teeth, the distal end of at least one of the tubular member and the longitudinally extending connector having a stop (166)(enlarged portion 30) to limit the relative telescoping movement of the adjustable extension, the tubular member having a spring biased pawl (74, 76) for engagement with one or more of the teeth of the rack adjacent the distal end of the tubular member, whereby the adjustable extension may be used in a selected variety of extended lengths to connect the proximal end of the tubular member to a driving tool and transmit driving force to a tool connected to the tool driving member at the distal end of the longitudinally extending connector.

Note that the limitation of a "rack with teeth" is considered met by the (52 (72) as broadly defined, however, in the alternative, as evident by McBride, notches in form of a longitudinal slots closely placed together (Fig. 2) or teeth as defined by Mathews to engage with the pawl, are known in the art. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Newby et al. with the "teeth" as taught by either McBride or Mathew to adapt the tool for more finer or smaller degree of adjustment.

Regarding claims 2-10, 10-15 and 17-20 as best understood, Newby et al. and/or Newby et al. in view of either McBride or Mathews meets the limitations.



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Conclusion

8. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Jackson, et al., Fowlkes, McBride, and Lyon are cited to show related inventions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 703-308-6279. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 703-308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Hadi Shakeri
Primary Examiner
Art Unit 3723
September 20, 2004